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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/879,913 | 06/14/2001 | Mitsuru Maeda | 35.C15455 | 5554 |

5514 7590 03/22/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/879,913 | | MAEDA, MITSURU | |
| | Examiner | | Art Unit | |
| | Matthew Heneghan | | 2134 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/1/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 have been examined.

Priority

2. The instant application claims priority to Japan Patent Application No. 2000-184,726, filed 20 June 2000.

Information Disclosure Statement

3. The following Information Disclosure Statement(s) in the instant application has been fully considered:

IDS filed 1 August 2001.

Drawings

4. Figures 1-6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Each figure illustrates material that is described in the "Background of the Invention" section of the specification.
5. The drawings are objected to because there are two reference numbers "116" both pointing to the same object in figure 7.

6. The drawings are objected to because on p.23, line 18, the specification refers to Comparator 211. It is presumed that this refers to Comparator 212.

7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claim 2 is objected to because of the following informalities: It recites "MEPG-4 encoded data," a non-existent format. It is being presumed that this refers to MPEG-4 encoded data. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1, 4-14, 17-20, and 22-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Each claim teaches solely to the abstract manipulation of data.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6, 10-12, 14-16, 21, 22, and 24-31 are rejected under 35 U.S.C. 102(b) as being anticipated by WIPO Patent Publication No. 99/48296 to Shamoon et al.

As per claims 1-3, 10-12, 14-16, 22, and 24-31 Shamoon discloses a streaming media system that includes a control block containing data from a Control Stream that is watermarked (i.e. combined into raw data) into audio and visual streams (see p. 7, lines 23-26). The Control is an IPMP (Intellectual Property Management and Protection) component (see p. 4, line 27 and p.5, lines 6-9 and p.21, lines 23-27) of an MPEG-4 stream (see column 4, lines 21-22) that includes rules governing use of intellectual property (see p.12, line 11 to p. 19, line 5).

As per claim 4, 17,18, the audio and visual streams may be encrypted prior to combining with the control stream (see p.4, lines 28 and 32).

As per claim 5, cryptographic keys for encrypting the data streams are initially contained in the Control Stream before being utilized in the Control Block during decryption (see p.5, lines 8-9 and p. 9, line 30 to p. 10, line 12). Since symmetric keys, such as DES (see p.26, lines 17-19) may be used, the encryption and decryption keys are the same.

As per claim 6, the encoding means is also capable of using public-key signatures (see p. 18, lines 10-13).

As per claim 21, received video is displayed (see p. 6, 19-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2134

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-9, 13, 17-20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Publication No. 99/48296 to Shamoon et al. as applied to claims 1, 12, 14, and 22 above, and further in view of U.S. Patent Publication No. 2001/0016851 to Gramsasmer et al.

Shamoon does not disclose the use of a data field in the intellectual property information that is related to patent details.

Gramsamer discloses an archiving and retrieval system wherein a Unique Identifier (UID) is watermarked into a document that denotes intellectual property information (see paragraph 12), with access policies are based upon the UID (see paragraphs 21, 22, and 25), and suggests the creation of such data based upon a patent number and country (see paragraph 7), and suggests that this provides a means for retrieving millions of patents of various countries.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Shamoon by including a UID indicative of patent information by country in the intellectual property information, as disclosed by Gramsamer, as this provides a means for retrieving millions of patents of various countries.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

Any response to this action should be mailed to:

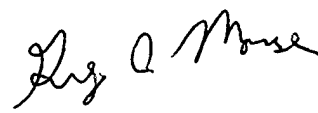
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GREGORY MORSE
SUPERVISOR, EBC
TECHNOLOGY CENTER 2100

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March 9, 2005